



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/682,997	11/06/2001	Michael S. Tignor	GEN-0286	4681
23413	7590	10/20/2003	EXAMINER	
CANTOR COLBURN, LLP 55 GRIFFIN ROAD SOUTH BLOOMFIELD, CT 06002			BENENSON, BORIS	
			ART UNIT	PAPER NUMBER
			2836	

DATE MAILED: 10/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

CC

<b>Office Action Summary</b>	<b>Application No.</b> 09/682,997	<b>Applicant(s)</b> TIGNOR ET AL.	
	<b>Examiner</b> Boris Benenson	<b>Art Unit</b> 2836	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 8/22/2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
     If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
     a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

Art Unit: 2836

**RESPONSE TO ARGUMENT**

1. Applicant argues that the prior art reference Leone et al. (5,490,086) that disclose a plug-in module comprising a memory element, which stores data representative of the module function, for plug-in into an electronic trip unit that includes a microprocessor doesn't disclose a steps of reading an identification register and validation of a plug-in module for operation with the microprocessor. The argument is convincing. The microprocessor of Leone et al. is recognizing a value stored in the memory of the module in order to evaluate what data should be transmitted to display unit and doesn't "perform a validation of said rating plug for operation with said microprocessor". Therefore a rejection of Claims 1,13,25 and 30 under 35 U.S.C. 102(b) as being anticipated by Leone et al. (5,490,086) is withdrawn.

2. Applicant correctly stated that in the prior art reference Murphy (4,958,252) not EEPROM but precision registers 43 and 45, located on a rating plug (7), is providing a microprocessor with data referencing the frame and the current rating of the circuit breaker and the value of resistor (45) is selectable to set desired current. Applicant correctly argues that second register (59) of EEPROM holds serial number of the circuit breaker to which the rating plug (7) is inserted and doesn't provide the

Art Unit: 2836

identification number of the rating plug for validation of the rating plug. Therefore a rejection of Claims 1,13,25 and 30 under 35 U.S.C. 102(b) as being anticipated by Murphy (4,958,252) is withdrawn.

### ***Allowable Subject Matter***

3. The following is a statement of reasons for the indication of allowable subject matter. Independent Claims 1,13,25 and 30 are allowable over prior art because none of the prior art of record disclose an electronic trip unit for a circuit breaker comprising a microprocessor and a rating plug, which include an identification register for holding an identification number of the plug and wherein the microprocessor performs a validation of the rating plug for operation with the microprocessor in combination with the other claim limitations.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

Art Unit: 2836

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1,13, 25 and 30 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,7, 12 and 16 of copending Application No. 09,682,512. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claim: an electronic trip unit for circuit breaker comprising: a microprocessor, said microprocessor programmed to determine an overcurrent condition of said circuit breaker; a nonvolatile memory in electronic communication with said microprocessor; a module plug releasably engaged with said microprocessor, said module plug includes an identification register; wherein said microprocessor reads said

Art Unit: 2836

identification register, said identification register including an identification number; wherein said microprocessor accesses one of a plurality of programs in said nonvolatile memory based said identification number; and wherein said one of a plurality of programs instructs said microprocessor to perform steps necessary to operate one or more functions of said module plug.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

This an obviousness-type double patenting rejection have been indicated in previous action. Application No. 09,682,512 has been allowed and Notice of Allowance has been mailed on 08/08/2003.

**THIS ACTION IS MADE FINAL.**

#### **Contact information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boris Benenson whose telephone number is (703) 305-6917. The examiner can normally be reached on M-F (8:20-6:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Sircus can be

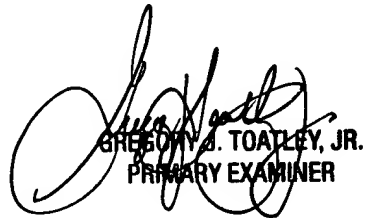
Art Unit: 2836

reached on (703) 308-3119. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Boris Benenson  
Examiner  
Art Unit 2836

B.B.



GREGORY J. TOATLEY, JR.  
PRIMARY EXAMINER